



INDEX

	Page
Opinions below	1
Jurisdiction	1
Question presented	2
Statute involved	2
Statement	3
Argument	4
Conclusion	12

CITATIONS

Cases:

<i>Abbot v. Coe</i> , 109 F. 2d 449	9
<i>Armstrong Co. v. Nu-Enamel Corp.</i> , 305 U. S. 315	11
<i>Beckwith v. Commissioner of Patents</i> , 252 U. S. 538	8
<i>Black Band Consolidated Coal Co. v. Glenn Coal Co.</i> , 57 App. D. C. 268	7
<i>Dennehy & Co. v. Robertson Co.</i> , 32 App. D. C. 355	7
<i>Elgin National Watch Co. v. Elgin Razor Co.</i> , 25 F. Supp. 886	10
<i>Elgin National Watch Co. v. Illinois Watch Co.</i> , 179 U. S. U. S. 665	10
<i>Ex Parte Boyle</i> , 125 Manuscript Decisions of the Commissioner of Patents 282, 8 T. M. Rep. 230	6
<i>Goodyear Co. v. Ray-O-Vac Co.</i> , 321 U. S. 275	5
<i>Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.</i> , 240 U. S. 251	7
<i>Illinois Watch Case Co. v. Shulton</i> , 111 F. 2d 298	10
<i>In Re Bonide Chemical Co., Inc.</i> , 46 F. 2d 705	6
<i>In Re Canada Dry Ginger Ale</i> , 86 F. 2d 830	10
<i>In Re Crescent Typewriter Supply Co.</i> , 30 App. D. C. 324	10
<i>In Re Deutz & Ortenberg, Inc.</i> , 54 App. D. C. 265	7
<i>In Re Hopkins</i> , 29 App. D. C. 118	6
<i>In Re International Resistance Co.</i> , 69 F. 2d 566	6
<i>In Re Meyer Brothers Coffee & Spice Co.</i> , 32 App. D. C. 277	8
<i>Johnson v. Brandau</i> , 32 App. D. C. 348	6
<i>Kentucky Distilleries & W. Co. v. Old Lexington Club Distilling Co.</i> , 31 App. D. C. 223	6, 8
<i>Manitou Springs Mineral Water Co. v. Schueler</i> , 239 Fed. 593	10
<i>Southeastern Brewing Co. v. Blackwell</i> , 80 F. 2d 607	7
<i>Thoddeus Davids Co. v. Davids</i> , 233 U. S. 461	10
<i>Williams Co. v. United Shoe Machinery Corp.</i> , 316 U. S. 364	5
<i>Worden v. California Fig Syrup Co.</i> , 187 U. S. 516	5

II

Statutes:	Page
Rev. Stat. § 4915, 35 U. S. C. 63.....	3
Trade Mark Act of March 3, 1881, 21 Stat. 502.....	10
Trade Mark Act of February 20, 1905, Sec. 5, 33 Stat. 725, as amended, 15 U. S. C. 85.....	2
Act of March 19, 1920, 41 Stat. 533, sec. 1 (b), 15 U. S. C. 121 (b).....	11
Miscellaneous:	
Derenberg, <i>Trade-Mark Protection and Unfair Trading</i> (1936).....	7
H. R. 1654, 79th Cong., 1st Seas.....	10, 11
Nims, <i>Unfair Competition and Trade-Marks</i> (3d Edition, 1929).....	6, 7
<i>Varieties of Cheese: Descriptions and Analyses</i> , United States Department of Agriculture Bulletin No. 608, 1943.....	5, 6

In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 1084

KRAFT CHEESE COMPANY, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the District Court of the United States for the District of Columbia (R. 36-37) is reported in 55 F. Supp. 24. The opinion of the Court of Appeals for the District of Columbia (R. 52-53) is reported in 146 F. 2d 313.

JURISDICTION

The judgment of the Court of Appeals was entered on December 18, 1944 (R. 54), and a petition for rehearing was denied on January 4, 1945 (R. 55). The petition for a writ of certiorari was filed on March 27, 1945. The jurisdiction of this Court is invoked under Sec-

tion 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether the mark, "Old English," as applied to a cheddar type cheese, is entitled to registration under the Trade-Mark Act of February 20, 1905, Section 5 of which prohibits the registration of a mark which "consists * * * merely in words or devices which are descriptive of the goods with which they are used" or which is "merely a geographical name or term * * *."

STATUTE INVOLVED

Section 5 of the Trade-Mark Act of February 20, 1905, 33 Stat. 725, as amended, 15 U. S. C. 85, provides, in part:

* * * no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

* * * * *

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, * * *: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual,

or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this act: * * *.

STATEMENT

On or about June 6, 1940, petitioner filed its application with the United States Patent Office to register the mark "Old English",¹ appearing in old English lettering, under the Trade-Mark Act of February 20, 1905, as a trade-mark for cheese (R. 2-3). The Examiner of Trade-Marks refused to register the mark "Old English" on the ground that the mark is "geographically descriptive of old English cheese," and thus "merely geographical" within the meaning of the proviso of Section 5 of the Act of February 20, 1905 (R. 49). This decision was affirmed on appeal by the First Assistant Commissioner of Patents (R. 50).

Petitioner thereupon brought suit in the United States District Court for the District of Columbia, under Section 4915 of the Revised Statutes (35 U. S. C. 63), to compel the Commissioner of Patents to allow the registration of the mark "Old English" under the 1905 Act (R. 1-4). After trial (R. 6-36), the district court dismissed

¹ Petitioner disclaimed the exclusive right to the use of the word "English" (R. 2, 37).

the complaint (R. 38), holding that "the meaning which the words 'Old English' would produce on a buyer would be that at least it represented cheese made in the Old English manner" (R. 37). On appeal, the United States Court of Appeals for the District of Columbia affirmed the dismissal of the complaint (R. 52-54).

ARGUMENT

1. Whether the mark "Old English" as a trade-mark for cheese is "fanciful" (Pet. 4, Br. 13-14, 18), and without "geographical or descriptive" significance (Br. 18) is a factual issue which has been decided adversely to petitioner's contentions. The district court found (R. 38):

4. The word "English" is geographical and the word "Old" is descriptive.

5. The meaning that the words "Old English" would produce on a purchaser of a package of cheese bearing those words, would be that, at least it indicated cheese made in the old English manner.²

The court below accepted and relied upon these findings of fact in reaching its decision (R. 52).

The finding of the Examiner of Trade-Marks (R. 49) and the Assistant Commissioner of

² The Examiner of Trade-Marks likewise found: "Old cheese has quite a vogue, as does, presumably, English cheese. The mark may therefore be regarded as geographical or as geographically descriptive of old English cheese" (R. 49). The Assistant Commissioner of Patents, in his decision, adopted this finding of the Examiner (R. 50).

Patents (R. 50), the independent finding of the district court (R. 38), and the acceptance of the district court's finding by the court below (R. 52-53), conclude petitioner's contrary contention that the mark is "fanciful", *Goodyear Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 278; *Abbot v. Coe*, 109 F. 2d 449, 451-452 (App. D. C.); *Williams Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367, and the evidence is sufficient to support these findings. The cheese which petitioner markets under the mark "Old English" is a cheddar type cheese (R. 32), and was sometimes marketed in packages labeled "Old English Pasteurized Process Cheddar Cheese" (R. 33). Cheddar cheese "is so named from the village of Cheddar in Somersetshire, England, where it was first made. It is comparatively an old cheese, though the genuine Cheddar process as it is now known is not old." *Varieties of Cheese: Descriptions and Analyses*, United States Department of Agriculture Bulletin No. 608, 1943, p. 10; see also R. 17.³ Clearly there-

³ In support of its claim that the mark "Old English" is used in a fanciful sense, petitioner contended in the district court and now seems to contend (Pet. 7) that the cheese which it markets under that mark is neither "Old" nor "English" (R. 13, 14, 31). Such a contention does not, however, aid the petitioner, for old and aged cheeses are well known, as are "English" type cheeses (see *Varieties of Cheese: Descriptions and Analyses*, United States Department of Agriculture Bulletin No. 608, 1943, p. 18; see R. 9) and the mark is therefore descriptive albeit inaccurate. A misdescriptive mark confers no rights either at common law (*Worden v. California Fig*

fore, the words "Old English," as applied to a cheddar type cheese,⁴ are not, as petitioner contends, "fanciful," but are, as the Examiner of Trade-Marks and the Assistant Commissioner of Patents found, "geographically descriptive of Old English cheese" (R. 49-50), and would, as the district court found, indicate to a prospective purchaser "cheese made in the old English manner" (R. 38).

2. Geographically descriptive marks were refused recognition as valid trade-marks at common law,⁵ and under the 1905 Act both the Patent Office and the courts have consistently denied registration to them. *Ex Parte Boyle*, 125 Manuscript Decisions of the Commissioner of Patents 282, 8 T. M. Rep. 230 ("Old English" as applied to floor wax); *In Re Hopkins*, 29 App. D. C. 118 ("Oriental Cream" as applied to face lotion); *Johnson v. Brandau*, 32 App. D. C. 348 ("Asbestos" as applied to shoes); *Kentucky Distilleries & W. Co. v. Old Lexington Club Distilling Co.*, 31 App. D. C. 223 ("Old Lexington Club" as *Syrup Co.*, 187 U. S. 516, 536-537, 539-540) or under the 1905 Act (*In Re Bonide Chemical Co., Inc.*, 46 F. 2d 705 (C. C. P. A.); *In Re International Resistance Co.*, 69 F. 2d 566 (C. C. P. A.)).

⁴ Other types of "English" cheese are not unknown. See description of "English Dairy" cheese in *Varieties of Cheese: Descriptions and Analyses*, *op. cit.*, *supra*, at p. 18; see also R. 32.

⁵ See cases cited in Nims, *Unfair Competition and Trade-Marks* (3d Edition, 1929), pp. 526-528, 538-542.

applied to whiskey); *Dennehy & Co. v. Robertson Co.*, 32 App. D. C. 355 ("Mountain Dew" as applied to whiskey); *In re Deutz & Ortenberg, Inc.*, 54 App. D. C. 265 ("House of France" as applied to dresses); *Black Band Consolidated Coal Co. v. Glenn Coal Co.*, 57 App. D. C. 268 ("Black Band" as applied to coal); see also cases cited in Nims, *Unfair Competition and Trade-Marks* (3d Edition, 1929), pp. 630-636, and in Derenberg, *Trade-Mark Protection and Unfair Trading* (1936), p. 257, *et seq.*

The petitioner's reliance (Br. 14-16) on *Hamilton-Brown Shoe Company v. Wolf Bros. & Company*, 240 U. S. 251, and *Southeastern Brewing Company v. Blackwell*, 80 F. 2d 607 (C. C. A. 4), is misplaced. Neither involved the Act of 1905, and both are, for this and other reasons, readily distinguishable. In the *Hamilton-Brown* case, the mark "American Girl" was held to have no significance as applied to shoes, and was thus regarded as neither geographical nor descriptive. But in the light of the findings in this case, it cannot be assumed that "Old English" has no geographically descriptive significance as a mark for cheddar cheese. In the *Southeastern Brewing* case, the words "Old South" or "Old South Brew", as applied to beer, were held to constitute a valid common-law trade mark. But there, contrary to petitioner's assertion (Br. 15), the court was moved by considerations of the mark's secondary

significance. (See *infra*, pp. 9-11.) The court stated that descriptive marks, if "merely suggestive, and especially if they had acquired, by use, a secondary significance", would be recognized as valid common-law trade-marks, and that "the words 'Old South Brew' * * * had acquired a secondary significance in the territory in which [appellant and its assignors] were operating" (p. 609).

3. Petitioner also contends that the court below failed to give "consideration to the fanciful meaning of the mark *in its entirety*," and that "In the case of 'Old English' the coupling together of the two separately unregistrable words has produced a new fanciful meaning" (Br. 16-18). Such a contention does not aid petitioner, for it is established that "a registrable mark cannot be made by combining two nonregistrable words". In *re Meyer Brothers Coffee & Spice Company*, 32 App. D. C. 277, 278; see also *Kentucky Distilleries & W. Co. v. Old Lexington Club Distilling Co.*, 31 App. D. C. 223. In *Beckwith v. Commissioner of Patents*, 252 U. S. 538, upon which petitioner relies (Br. 16), this Court held that the words "Moistair Heating System" standing alone could not be registered because they were "merely descriptive" (p. 544), and that they could be registered under the 1905 Act only as part of a composite mark comprising the head of an Indian Chief named "Doe-Wah-Jack" and the words "Round Oak". As the court below pointed out,

"No doubt if the phrase 'Old English' had been an integral part of some peculiar design or seal such an arbitrary arrangement could have been registered. But that is not the case here. The only peculiarity of this trade-mark is the fact that [petitioner] uses a familiar Gothic type." (R. 53.)

4. Petitioner argues "that the composite mark 'Old English' serves to distinguish petitioner's cheese from that of other manufacturers," that it "qualifies for registration under the general language of section 5 of the 1905 Act," and "is not disqualified by any of the provisos or exceptions in said section" (Br. 18). As a descriptive or geographical mark, however, the words "Old English" could serve "to distinguish Petitioner's cheese from that of other manufacturers" only through the acquisition of a secondary meaning, which in turn would result from long usage and a general recognition of the mark by the public as identifying petitioner's product. Derenberg, *op. cit.*, *supra*, at pp. 338 *et seq.*

But petitioner does not argue that its mark has acquired a secondary meaning, no doubt because the only "descriptive * * * or merely * * * geographical" marks presumed to have a secondary meaning under the 1905 Act are those registrable under the ten-year provision of Section 5—*i. e.*, those which were used exclusively and in good faith for ten years prior to the passage of

the 1905 Act. See *Thaddeus Davids Co. v. Davids*, 233 U. S. 461, 470; *Illinois Watch Case Co. v. Shulton*, 111 F. 2d 298, 299 (C. C. P. A.); *Manitou Springs Mineral Water Co. v. Schucler*, 239 Fed. 593, 602 (C. C. A. 8); *Elgin National Watch Co. v. Elgin Razor Company*, 25 F. Supp. 886, 887 (N. D. Ill.). Since petitioner did not seek registration of the words "Old English" under the ten-year provision, no secondary meaning or arbitrary or fanciful usage can except the mark from the proviso of Section 5 of the 1905 Act prohibiting the registration of "descriptive * * * or merely * * * geographical marks." *In re Crescent Typewriter Supply Co.*, 30 App. D. C. 324; *In re Canada Dry Ginger Ale*, 86 F. 2d 830 (C. C. P. A.); see also *Elgin National Watch Co. v. Illinois Watch Co.*, 179 U. S. 665, where this Court recognized the established secondary meaning of the word "Elgin" as a trade-mark for watches, but refused it registration under the Trade-Mark Act of March 3, 1881, 21 Stat. 502 (the predecessor of the 1905 Trade-Mark Act) because it was a "geographical name" (p. 677).⁶ In these circum-

⁶ Pending legislation in the 79th Congress reveals a recognition of the current state of the law in this regard—*i. e.*, with the exception of marks falling within the ten-year provision of Section 5 of the 1905 Act, geographical or descriptive

stances, the Patent Office and the courts below properly refused registration to petitioner's mark.⁷

marks are not registrable under that Act, even though such names or marks may have acquired secondary significance. Section 2 (f) of H. R. 1654, 79th Cong., 1st Sess., an Act "To provide for the registration and protection of trade-marks used in commerce * * *," permits the registration of descriptive or geographically descriptive marks if, "as used by the applicant," they have "become distinctive of the applicant's goods in commerce." In such circumstances, the Commissioner of Patents "may accept as *prima facie* evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration." H. R. 1654 was passed by the House of Representatives on March 5, 1945, and on March 6, 1945, was referred by the Senate to its Committee on Patents.

⁷ The ruling of the court below does not estop petitioner from seeking registration of its mark under Section 1 (b) of the Act of March 19, 1920 (41 Stat. 533, 15 U. S. C. 121 (b)), which permits the registration of marks not registrable under the proviso of Section 5 of the 1905 Act "which have been in bona fide use for not less than one year in interstate or foreign commerce." Indeed, the Commissioner of Patents noted in his decision that petitioner's "mark is registrable, if at all, under the Act of March 19, 1920" (R. 50). The provisions of the 1920 Act were recently examined by this Court in *Armstrong Co. v. Nu-Enamel Corp.*, 305 U. S. 315, where it was stated that the "obvious purpose of [Section 1 (b) of the 1920 Act] was to widen the eligibility of marks" not registrable under the proviso of Section 5 of the 1905 Act (p. 330).

CONCLUSION

The decision below is correct and rests on the particular facts of this case. There is no conflict of decisions. The petition for a writ of certiorari should therefore be denied.

Respectfully submitted.

HUGH COX,
Acting Solicitor General.

FRANCIS M. SHEA,
Assistant Attorney General.

PAUL SWEENEY,
JEROME H. SIMONDS,
Attorneys.

W. W. COCHRAN,
Solicitor,

R. F. WHITEHEAD,
Attorney,
United States Patent Office.

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